

REMARKS

The Office Action of December 6, 2005 was received and reviewed. The Examiner is thanked for reviewing the application.

Filed concurrently herewith is a *Request for a One Month Extension of Time* which extends the shortened statutory period of response to April 6, 2006. Accordingly, Applicants respectfully submit that this response is being timely filed.

Claims 1, 77-84, 87-90 and 93-102 were pending prior to the instant amendment for consideration. By this amendment, claims 1, 77-80, 87-90, 93-96 and 98-102 have been amended, and new claims 103-107 have been added. Accordingly, claims 1, 77-84, 87-90 and 93-107 are pending for consideration, of which claims 1, 77-80 are independent.

Referring now to the detailed Office Action, claims 1, 77-84, 87-90 and 93-102 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the feature "*a first region of the floating gate is located in an upper region of the channel forming region, ... a second region of the control gate is located in the upper region of the channel forming region*" is not supported by the specification. In response, Applicants have amended independent claims 1 and 77-80, as shown above, to delete the above-mentioned features.

Claims 1 and 102 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yamazaki et al. (JP 11-154714 and the Derwent Translation of this document – hereafter Yamazaki), Akbar (U.S. Patent No. 5,656,845 – hereafter Akbar) and Miyawaki (U.S. Patent No. 5,808,336 – hereafter Miyawaki). Further, claims 77-84, 87-90 and 93-96 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yamazaki, Akbar and Miyawaki, as applied to Claim 1 above, and further in view of Koyama (U.S. Patent No. 5,793,344 – hereafter Koyama). Still further, claims 97-101 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yamazaki, Akbar, Miyawaki and Koyama, as applied to Claims 1 and 77-80 above, and further in view of Fukaya et al. (U.S. Patent No. 5,627,088 – hereafter Fukaya).

In response to the obviousness rejections summarized above, Applicants have amended all the pending independent claims to recite the feature "*wherein the control gate is a laminate film, wherein a first film of the laminate film comprises tantalum nitride, wherein a second film of the laminate film comprises tungsten, and wherein a third film of the*

laminate film comprises tungsten nitride", as shown above. Support for the amended features can be found at least on, e.g., page 27, lines 10-16 of the specification. Applicants respectfully assert that none of the cited prior art references teach, disclose or suggest the amended features in combination with the other claimed features.

The requirements for establishing a *prima facie* case of obviousness, as detailed in MPEP § 2143 - 2143.03 (pages 2100-122 - 2100-136), are: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the teachings; second, there must be a reasonable expectation of success; and, finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. As the cited prior art references fail to teach, disclose or suggest the amended features in combination with the other claimed features, as noted above, a *prima facie* case of obviousness has not been established.

Claims 1 and 75-96 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-12 of U.S. Patent No. 6,472,684 to Yamazaki et al. (hereafter Yamazaki '684) in view of Yamazaki, Akbar, Miyawaki and Koyama. Further, claims 1 and 75-96 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,509,602 to Yamazaki et al. (hereafter Yamazaki '602) in view of Yamazaki, Akbar, Miyawaki and Koyama. These double patenting rejections are respectfully traversed for the reasons provided below.

In regard to the double patenting rejections, Applicants respectfully note that claims 75, 76, 85, 86, 91 and 92 have been canceled previously. Hence, the rejection of claims 75, 76, 85, 86, 91 and 92 is moot. Further, Applicants respectfully assert that claims 1-12 of Yamazaki '684 and claims 1-30 of Yamazaki '602 do not recite the amended features, and that Yamazaki, Akbar, Miyawaki and Koyama do not teach, disclose or suggest the amended features in claims 1 and 77-80.

MPEP 804 (page 800-22 Aug. 2001 Edition) states the following:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure.

Accordingly, the burden is on the Office to establish why one of ordinary skill in the art would conclude that the invention recited in the instant claims 1, 77-84, 87-90 and 93-96 is an obvious variant of the invention recited in claims 1-12 of Yamazaki '684 and claims 1-20 of Yamazaki '602, each in combination with Yamazaki, Akbar, Miyawaki and Koyama. That is, there must be a suggestion or teaching in the prior art that would motivate one of ordinary skill in the art to modify the invention recited in claims 1-12 Yamazaki '684 and claims 1-20 of Yamazaki '602, each in combination with Yamazaki, Akbar, Miyawaki and Koyama to reach the invention recited in the instant amended claims 1 and 77-80. With the amendment of claims 1 and 77-80 above, Applicants respectfully submit that the Examiner has a burden to make clear points (A) and (B) as stated in the MPEP.

Applicants have further amended independent Claims 1, 77-80 and 102, as shown above, to replace "a floating gate" with "a layer ..., wherein the layer... traps electrons" in order to further clarify the invention. Support for this amendment can be found at least on, e.g., page 12, line 3 to page 13, line 3 of the specification. In addition, Applicants have amended claims 87-90, 93-96 and 98-101, as shown above, in order to correct the typographical error of the preamble.

New claims 103-107 have been added to further complete the scope to which Applicants are entitled.

In view of the foregoing, it is respectfully requested that the rejections of record be reconsidered and withdrawn by the Examiner, that claims 1, 77-84, 87-90 and 93-102 be allowed, that new claims 103-107 be allowed and that the application be passed to issue. If a conference would expedite prosecution of the instant application, the Examiner is hereby invited to telephone the undersigned to arrange such a conference.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Luan C. Do', written over a horizontal line.

Luan C. Do
Registration No. 38,434

NIXON PEABODY LLP
Suite 900, 401 9th Street, N.W.
Washington, D.C. 20004-2128
(202) 585-8000